<u>REMARKS</u>

<u>Status of the Claims</u>

Claims 1–27 remain pending in the application, Claims 14 and 27 having been amended to more clearly distinguish the claimed subject matter over the cited art.

<u>Brief Summary of Telephone Interview</u>

On July 13, 2006, applicants' attorney discussed the current Office Action Response (proposed, but not yet officially submitted at the time of the interview) with Examiner Ke during a telephone interview. The discussion focused on independent Claim 1's recitation, "that the palette comprises a control only for an available property," and how applicants' attorney perceived that this language in the claim distinguishes over the cited art of Buxton in view of Grossman. In addition, the discussion also focused on the amendment of independent Claim 14 to distinguish over the cited Buxton and Berry references. Buxton is directed towards an infocenter user interface for applets and components, Grossman is directed towards a method and system for facilitating the selection of icons, and Berry is directed towards methods of displaying help information nearest to an operation point at which the help information is requested.

With respect to independent Claim 1, applicants' attorney asked Examiner Ke to clarify his interpretation of Buxton and Grossman to explain where these references teach applicants' claim recitation, "that the palette comprises a control only for an available property," which was discussed by the Examiner briefly under the section entitled "Response to Argument" in the Final Office Action dated April 20, 2006. Applicants' attorney then clarified that the current arguments submitted herein (and also submitted for review prior to the interview) explain how she perceives Buxton as teaching how to treat *unavailable icons*, while Grossman teaches treating *available* icons (i.e., handling icons that have not been used for a period of time).

With respect to independent Claim 14, applicants' attorney asked Examiner Ke if he perceived that the claim amendment distinguishes over Berry. Applicants' attorney briefly pointed out with respect to Berry, how she perceives that the subject matter distinguishes over FIGURE 2 and FIGURE 3 of Berry (and the corresponding text in Berry's specification). Examiner Ke then indicated that this amendment would most likely distinguish over the cited art, but further indicated that he may perform another search to attempt to identify other relevant art.

1 Applicants' attorney would like to again thank Examiner Ke for his time and willingness to
2 discuss these issues during the telephone interview.

3 Claims Rejected under 35 U.S.C. § 103(a)

4 The Examiner has rejected Claims 1-13 as being unpatentable over Buxton et al. (U.S. Patent
5 No. 6,469,714, hereinafter "Buxton") in view of Berry et al. (U.S. Patent No. 4,789,962, hereinafter
6 "Berry") and in view of Grossman et al. (U.S. Patent No. 5,852,440, hereinafter "Grossman"). The
7 Examiner has also rejected Claims 14-27 as being unpatentable over Buxton in view of Berry. Applicants
8 respectfully disagree with these rejections for the reasons discussed below.

9 In the interest of reducing the complexity of the issues for the Examiner to consider in this
10 response, the following discussion focuses on independent Claims 1, 14, and 27. The patentability of
11 each remaining dependent claim is not necessarily separately addressed in detail. However, applicants'
12 decision not to discuss the differences between the cited art and each dependent claim should not be
13 considered as an admission that applicants concur with the Examiner's conclusion that these dependent
14 claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to
15 discuss differences between the prior art and every claim element, or every comment made by the
16 Examiner, should not be considered as an admission that applicants concur with the Examiner's
17 interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent
18 claims patentably distinguish over the references cited. However, a specific traverse of the rejection of
19 each dependent claim is not required, since dependent claims are patentable for at least the same reasons
20 as the independent claims from which the dependent claims ultimately depend.

21 Patentability of Independent Claim 1

22 Significant differences exist between the recitation of independent Claim 1 and the cited art
23 because motivation to combine the cited art does NOT exist and in the alternative, even if combined,
24 the cited art does NOT teach or suggest all of the recited details of this claim, i.e., do not teach a
25 palette that comprises a control only for an available property.

26 The Examiner asserts that although Buxton and Berry fail to teach displaying only the
27 controls that are available, Grossman teaches displaying only the icons that are active, and cites
28 column 9, lines 60-66 of Grossman, which are italicized below to highlight that portion of the quote:

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In a further effort to clean up a computer display or a messy desk top, a technique is provided wherein the visual clutter is reduced by gradually removing those elements from the display which have not been recently used, and optionally, closing the associated computer sessions in order to reduce the processor load. As described below, in accordance with the principles of the present invention, desk top elements, such as icons, which have not been used for some time or with a low expected probability of use have a gradual change in their appearance. As examples, they may grow hazy or fade into the background, their actual dimensions may be changed so that they shrink until they disappear or they shrink along one dimension appearing to be squashed, they move or drift to the edge of the display or they have an intensity border which grows along the perimeters of the icons the longer the icons have been inactive. *With the intensity border, in a further example, once the border is complete, the icon is considered unused beyond a predefined time-out limit and it is removed from the screen. Selecting the icon would reset the intensity border. For instance, a 3600 pixel border could have one pixel illuminated every one second.* At the end of one hour, for this example, the icon's intensity border would be complete and the inactive icon would be removed to free system resources, such as, for example, an OS/2 thread. (Emphasis added, Grossman, column 9, lines 45- column 10, line 2.)

The Examiner asserts that it would have been obvious to an artisan at the time of the invention to include Grossman's teaching with the method of Buxton and Berry in order to increase system resources or space on the user's desktop (Office Action, pages 8-9). In addition, the Examiner explains that the combination of Buxton and Grossman teaches this limitation because the Examiner is replacing Buxton's method of treating a non-active icon with that of Grossman, but not Buxton's method of determining a non-active icon. Both Buxton and Grossman determine whether an icon is active, and if it not, Buxton dims the display of the icon, while Grossman deletes the icon from the screen. The Examiner also cites Buxton, column 7, lines 59-67 and Grossman column 9, lines 45- column 10, lines [*not indicated*], as reproduced above. Therefore, by combining Buxton's method of determining a non-active icon with Grossman's method of deleting the non-active icon, the Examiner concludes that only the icons for an available property would be displayed on a palette. (Office Action, pages 12-13). Applicants respectfully disagree.

Grossman and Buxton would not logically be combined by one of ordinary skill in the manner asserted by the Examiner, because they do NOT both treat non-active icons as the Examiner asserts, but instead are directed towards treating available, but unused icons and unavailable action items, respectively. In other words, Grossman's method is directed towards treating available, but dormant icons that have not been used for a period of time, while Buxton's method is directed towards treating

unavailable action items (i.e., items that can't be used). Grossman teaches that icons, which have not been used for some time or have a low expected probability of use, may have their actual dimensions changed so that they shrink until they disappear (Grossman, column 9, lines 52-56). In other words, these icons were once available and were either: (1) not used for a predetermined amount of time; or, (2) the software determined that it is unlikely these icons would be used. But, it is important to note that the icons in Grossman **were once available** for use in the current instance of the application. *Thus, Grossman is directed towards a method of treating **available** icons.*

Buxton teaches dimming action items 324 that are not available in the current context (Buxton, column 7, lines 61-62). In other words, action items 324 that are unavailable are dimmed. *Thus, Buxton is directed towards a method of treating **unavailable** action items.* It is therefore inappropriate to classify Grossman and Buxton as both treating non-active icons, and one of ordinary skill in this art would not be led to make the combination proposed by the Examiner. In conclusion, applicants submit that motivation to combine a method of treatment of available icons and a method of treatment of unavailable action items does not exist because treating **available** items, as taught by Grossman, and treating **unavailable** items, as taught by Buxton, are solutions to very different problems that are fundamentally distinct and unrelated.

In the alternative, even if one did combine Grossman's treating of available icons with Buxton's treating of unavailable action items, the result would be a composite method where if out of five icons, two icons are available but unused and three icons are unavailable, the combined teaching of these two references would eliminate the two available but unused icons after a predetermined amount of time has elapsed without use, but would dim the three unavailable icons. The result of such a combination would thus NOT be a palette that comprises a control only for an available property.

Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 103(a) over Buxton in view of Berry and further in view of Grossman should be withdrawn. Because dependent claims include all of the elements of the independent claims from which the dependent claims ultimately depend, and because Buxton in view of Berry and further in view of Grossman does not disclose or suggest all of the elements of independent Claim 1, the rejection of dependent Claims 2-13 under 35 U.S.C. § 103(a) over Buxton in view of Berry and further in view of Grossman should be withdrawn for at least the same reasons as the rejection of Claim 1.

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Patentability of Independent Claim 14

Significant differences exist between the recitation of independent Claim 14 and the cited art because the cited art does NOT teach or suggest that a palette and an activated associated content of the palette does not obscure the viewing content area occupied by the electronic document. The fourth portion of the second step is recited by applicants in amended Claim 14 as:

> *sending the palette to a user interface associated with the application program for display adjacent to a viewing content area occupied by the electronic document,* **such that the palette and an activated associated content of the palette do not obscure** any portion of **the viewing content area occupied by the electronic document** regardless of whether the electronic document occupies all portions of the viewing content area (Emphasis added.)

The Examiner's attention is directed to FIGURE 5, which is a graphical depiction of a user interface of a property browser program module displayed in conjunction with an electronic document associated with an application program in one exemplary embodiment of the present invention. In this example, notice that formatting palette 502 of user interface 500 is displayed *adjacent* to the area of where viewing content 506 is to be viewed, and formatting palette 502 includes divider headers (i.e., associated content) such as "Font," "Alignment and Spacing," "Borders and Shading," and "Document." Notice also that associated content "Font" has been activated and shows property labels and controls such as "Style," "Name," "List," and pull down menus. Further notice that this activated associated content does not obscure the area of viewable content 506 occupied by electronic document 504. Thus, applicants' FIGURE 5 illustrates an example of how the palette is sent to a user interface associated with the application program for display adjacent to a viewing content area occupied by the electronic document, such that the palette and an activated associated content of the palette do not obscure the viewing content area occupied by the electronic document.

In contrast, the cited art does NOT teach or suggest that a palette and an activated associated content of the palette do not obscure the viewing content area occupied by the electronic document, because any activated associated content, if activated at all, in Berry *is not associated with the palette*. The Examiner asserts that Buxton teaches the italicized portion of applicants' above step, i.e., sending the palette to a user interface associated with the application program for display adjacent to a viewing content area occupied by the electronic document. The Examiner cites

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Figure 3A, items 300 and 320. In addition, the Examiner asserts that Berry teaches the bold font portion of applicants' step that is quoted above, i.e., the provision that the palette and an activated associated content of the palette do not obscure the viewing content area occupied by the electronic document, and in support of his assertion, cites column 4, lines 1-35 and column 4, lines 58-67 of Berry. The Examiner asserts that it would have been obvious to an artisan at the time of the invention to include Berry's teaching with the method of Buxton in order to reduce the potential for error.

The Examiner has not indicated which elements in Berry that he believes are equivalent to applicants' recited elements of *a palette, activated associated content*, and *electronic document*. With respect to the Examiner's citation that discusses Berry's FIGURE 2, assuming for the sake of argument that the Examiner intended to equate Berry's command line 14 of FIGURE 2, "QUICK HELP: MARGINS," and selection menu screen 11 with applicants' palette, activated associated content, and electronic document, respectively, notice that "QUICK HELP: MARGINS" does not result from command line 14 but instead results from selection menu screen 11. Berry discloses that with the underline under MARGINS, depression of a HELP, or equivalent function key on the keyboard will result in help being displayed (Berry, column 4, lines 17-19). Thus, Berry's help being displayed results not from manipulation of command line 14, but instead, due to the manipulation of the electronic document.

With respect to the Examiner's citation that discusses FIGURE 3, also assuming for the sake of argument that the Examiner intended to equate windowing menu 16 and windowed help 17 with applicants' palette and activated associated content, respectively, notice that the viewing content area on screen 15 is still obscured by windowed help 17. It is conceivable that when an electronic document occupies a viewing content area, portions of the viewing content area are not obscured by the text and graphics of the electronic document. In other words, there can be blank areas in the viewing content area of the electronic document. Thus, for clarification purposes, as highlighted in the underlined portions above, applicants have amended this step in Claim 14 to make clear that even these blank areas are not obscured by the palette and the activated associated content of the palette.

Accordingly, the rejection of independent Claim 14 under 35 U.S.C. § 103(a) over Buxton in view of Berry should be withdrawn. Because dependent claims inherently include all of the elements of the independent claims from which the dependent claims ultimately depend, and because Buxton in view

of Berry does not disclose or suggest all of the elements of independent Claim 14, the rejection of dependent Claims 15-26 under 35 U.S.C. § 103(a) over Buxton in view of Berry should be withdrawn for at least the same reasons as the rejection of Claim 14.

<u>Patentability of Independent Claim 27</u>

Independent Claim 27 is directed towards a computer system for providing a selection of formatting properties for an electronic document associated with an application program having a user interface. The Examiner has rejected Claim 27 under the same rationale as Claim 14. Applicants have amended the third subparagraph of the last step in Claim 27, as shown by the added underlined text, to recite:

> replacing the palette with the modified palette so that the modified palette is displayed adjacent to a viewing content area occupied by the electronic document on the user interface, said modified palette being displayed such that the modified palette and an activated associated content of the modified palette do not obscure <u>any portion of</u> the viewing content area occupied by said electronic document <u>regardless of whether the electronic document occupies all portions of the viewing content area.</u>

Thus, for the same reasons already noted above in traversing the rejection of Claim 14, Claim 27 also distinguishes over Buxton in view of Berry, because unlike the teaching of the cited art, the claim provides that the modified palette and its associated content are displayed adjacent to the viewing area of the electronic document so as not to obscure any portion of the viewing area of the electronic document.

Accordingly, the rejection of independent Claim 27 under 35 U.S.C. § 103(a) over Buxton and further in view of Berry should be withdrawn.

In view of the Remarks set forth above, it will be apparent that the claims remaining in this application define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,


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